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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,353	12/12/2003	Lawrence W. Hu	GUID-011CON2	3571

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Law Office of Alan W. Cannon
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EXAMINER	
MAI, HAO D	

ART UNIT	PAPER NUMBER
3732	

MAIL DATE	DELIVERY MODE
11/12/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/734,353	HU ET AL.	
	Examiner	Art Unit	
	HAO D. MAI	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 July 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,5-10,12,13,15,16,84-108 and 113-120* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *115-120* is/are allowed.

6)☒ Claim(s) *1,2,5-10,12,13,15,16,84-108 and 113-114* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. **Claims 1-2, 5-10, 12-13, 15-16, 101-108, and 113-114, are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 5-10, 12-13, and 15-16, of U.S. Patent No. 6,685,632 B1 in view of Dobrovolny (5,899,627).**

The Patent '632 claims do not include the first articulating joint providing three degrees of freedom. However, it is well known in the connector or joint field to utilize a ball and socket joint in order to obtain more degrees of freedom. For example, Dobrovolny discloses an articulating joint of ball 19 providing at least 3 degrees of freedom. It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the first articulating joint with a ball and socket joint as a mere substitution of alternative suitable joint. Furthermore, the subject matter claimed in the instant application is fully disclosed in the patent and is covered, i.e. claimed, by the patent since the patent and the application are claiming common subject matter. It is the applicant's burden to establish that the invention of the instant claims is independent and distinct from the invention claimed in the patent.

3. **Claims 84-100 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 5 of U.S. Patent No. 6,685,632 in view of Hancock (6,331,157 B2).** The Patent '632 claims do not include a retractor with a drive mechanism driving the retractor blades. Hancock shows a retractor system comprising a drive mechanism 22 and first and second retractor blades 24, 26 being drivable or spreaded apart by the drive mechanism 22 (Fig. 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the Patent claims with the retractor shown by Hancock as an alternate stable support for the instrument mount and stabilizer.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 84-89, 92-94, and 97-100, are rejected under 35 U.S.C. 102(e) as being anticipated by Cartier (6,102,854).**

Cartier discloses a surgical system (Figs. 1A-2) comprising: a retractor 1 including a drive mechanism 2, first and second retractor blades 7 capable of engaging opposite sides of the incision, at least one of said first and second retractor blades 7 being drivable by the drive

mechanism 2. The surgical system further comprises an instrument mount assembly 50 having a clamping mechanism 521 (best shown in Fig. 3) mountable to a portion of at least one of said first and second retractor blades 7. The instrument mount assembly 50 is capable of receiving and fixing a surgical instrument 60 in multiple locked, unlocked, or partially-locked configurations with respect to itself. The instrument mount assembly 50 is also capable of fixing itself in multiple locked, unlocked, or partially-locked configurations with respect to the retractor (Fig. 1). Cartier et al. further disclose a single actuator 51 which is also a quick-release mechanism which can lock and unlock two joints included in the instrument mount assembly; the first joint 53 jointing 52 to 55, the second joint 54/56 joining rod 60 to the mount assembly.

Also note the stabilizer 30 mounted to the retractor via instrument mount assembly 50 (Fig. 2). The instrument mount assembly 50 can be fixed to said retractor while the surgical instrument 60 or 30 can be positioned with respect to said instrument mount assembly. The surgical instrument may still be moved under frictional resistance when in a partially-locked configuration.

6. **Claims 101-103 and 105-106 are rejected under 35 U.S.C. 102(b) as being anticipated by LeVahn et al. (4,949,707).**

Regarding claim 101, LeVahn et al. disclose an instrument mount apparatus, e.g. 118 or 120, for positioning a surgical instrument, e.g. 126 or 132 (Fig. 1). The apparatus comprising: a grip member 136 (best shown in Figs. 4-5) capable of being locked to and released from a stable support, e.g. frame rod 108 (as shown in Fig. 1). The mount apparatus further comprises a first joint member 156 capable of allowing movement, in an unlocked configuration, of an upper portion 140 of said grip member relative to a lower portion 138 of said grip member, said lower portion 138 is capable of being locked and released from said stable support; and at least

one second joint member 182 external of and spaced from said first joint member 156, said second joint member is capable of movably connecting the surgical instrument (retractor handle 184) to the grip member 136. The apparatus further comprises a locking mechanism wherein said locking mechanism is actuable via a single actuator 146 to both lock said first joint member 156 and lock an orientation of the surgical instrument with respect to said grip member (Figs. 4-5).

As to claims 102-103, 105-106, LeVahne et al. disclose the stable support being a retractor, wherein the grip member is capable of attaching to the stable support and reamin slidable with respect thereto, prior to locking said grip member. Note that both joint members 156 and 182 are rotational and the surgical instruments as shown are retractor blades or stabilizers linked to the second joint member.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. **Claims 95-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cartier (6,102,854) in view of Hancock (6,331,157 B2).**

Cartier et al. disclose the invention substantially as claimed in claims 84. However, Cartier et al. are silent to the open slots on the retractor blade for receiving and securing sutures therein.

Hancock discloses a retractor having suturing lots 66 on the retractor blade (Fig. 11). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cartier et al. by including the suturing slots in order to receive and secure sutures therein.

9. **Claim 104 is rejected under 35 U.S.C. 103(a) as being unpatentable over LeVahn et al. in view of Dobrovolny (5,899,627).**

LeVahn et al. disclose the invention substantially as claimed except for at least one joint member comprises a ball joint. Dobrovolny disclose a similar instrument mount comprising a second joint member 19/52 being a ball joint. It would have been obvious to one having ordinary skill in the art at the time the invention was made to
Modify LeVahn et al. by substituting the bore and rod second joint with a ball and socket joint in order to obtain more degrees of freedom as taught by Dobrovolny.

10. **Claims 107 and 108 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeVahn et al. in view of Benetti et al. (2001/0044572).**

LeVahn et al. disclose the invention substantially as claimed according to claims 101-106. However, LeVahn et al. fail to disclose the stabilizer comprising a plurality of interconnecting links articulating with the joint member and the stabilizer.

Benetti et al. show a stabilizer system comprising an instrument mount, a stabilizer where the mount and the stabilizer are connected by a plurality of interconnecting links (Fig. 6). A cable runs through the links and when a tension is applied thereto, the links are fixed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to

replace the rod of LeVahn et al., with the flexible system of Benetti to enable the surgeon to place the stabilizer in many more orientations.

Allowable Subject Matter

11. Claims 115-120 are allowed. Claims 1-2, 5-10, 12-13, 15-16, and 113-114, would be allowable if amended or filing a terminal disclaimer to overcome the double patenting rejection.

Response to Arguments

12. Applicant's arguments filed on 07/15/2009 have been fully considered but are moot in view of new ground(s) of rejection. Applicant's remarks are held to be responded to in the above ground(s) of rejection. It is noted that Applicant mentioned submitting a terminal disclaimer. However no terminal disclaimer has been submitted; the double patenting ground(s) of rejection is thus maintained.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAO D. MAI whose telephone number is (571)270-3002. The examiner can normally be reached on Monday-Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached at (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hao D Mai/

Examiner, Art Unit 3732

/Cris L. Rodriguez/
Supervisory Patent Examiner, Art Unit 3732